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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/512,101	10/21/2004	Michael Rooke	915-006.054	6418

4955 7590 02/06/2008
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EXAMINER

HOLLIDAY, JAIME MICHELE

ART UNIT	PAPER NUMBER
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2617

MAIL DATE	DELIVERY MODE
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02/06/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/512,101

Applicant(s)

ROOKE ET AL.

Examiner

Jaime M. Holliday

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-12 and 15-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

Response to Arguments

Applicant's arguments filed November 8, 2007 have been fully considered but they are not persuasive.

Applicants basically argue that neither Salin et al. nor Rooke et al. disclose receiving a status change message and then initiating a delivery attempt. Examiner respectfully disagrees, because Salin et al. does disclose alerting the SMS-GMSC when the mobile station is again reachable (receiving status change notification of availability). However, Salin et al. does not ***specifically*** disclose that the availability information is one of a "*group of type of message, size of the message, data content of the message, location of said mobile terminal device and willingness of a user of said mobile terminal device to receive a message.*" Rooke et al. is then incorporated to overcome the previous limitation by teaching that the decision how to handle the submission is based on the circumstance that content(s), size and type(s) of the multimedia message, the capabilities of the terminal, and the user profile of a subscriber related to said terminal are available to respective decision means.

Therefore, in view of the preceding arguments, Examiner maintains previous rejections.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
3. **Claims 1, 3-12 and 15-19** are rejected under 35 U.S.C. 103(a) as being obvious over **Salin et al. (U.S. Patent # 6,370,390 B1)** in view of **Rooke et al. (Pub # U.S. 2002/0044634 A1)**.

Consider **claims 1, 9-12 and 17**, Salin et al. clearly show and disclose a method for delivering short messages to mobile stations. Salin et al. further disclose a situation where a mobile station MS is attached to a GPRS network and a GSM network, and the short message service center (SM-SC) has received a short message (SM) for delivery to the mobile station, but the mobile station cannot be reached. The SM-SC first forwards the short message to the gateway mobile switching center for short message service (SMS-GMSC) which proceeds to request routing information for the short message from the home

location register (HLR) of the mobile station, (abstract, column 7 lines 60-65 and column 8 lines 8-16) characterized by: sending a Set Message Waiting Data message to the HLR of the MS in response to a failed delivery attempt (Failure Report) to the SMS-GMSC, reading on the claimed "a method (software tool; computer program product; computer program product; apparatus) comprising receiving a notification from a store and forward entity about an unsuccessful delivery attempt of a message to a mobile terminal device," (figure 2, column 8 lines 39-42 and 59-62) and acknowledging receipt of Set Message Waiting Data message from SMS-GMSC to HLR, reading on the claimed "subscribing (component; means) to a presence service for receipt of notifications about the attainability of said mobile terminal device," (figure 2, column 9 lines 1-4), sending alert message to SMS-GMSC, in response to mobile station updating its routing area to the serving node (SGSN) and the serving node sending this information to the HLR, (figure 2, column 9 lines 20-22, 30-32 and 35-37), forwarding short message to SMS-GSMC when SM-SC receives an alert message from the SMS-GMSC, (figure 2, column 9 lines 45-52), the SMS-GMSC examines the address of the mobile station and request routing information from the HLR which returns an acknowledgment of the message with the current SGSN address and the MSC/VLR address of the mobile station. The SGSN sends information on the fact that the mobile station is again reachable to the HLR which sends an alert message to the SMS-GMSC. The SMS-GMSC then sends an alert message to the SM-SC, which then forwards the short message to

the SMS-GMSC, reading on the claimed "receiving a status change notification message from said presence service about said mobile terminal device having a change of said availability information, and initiating (component; means) a delivery attempt of said message to said mobile terminal device upon receipt of notifications about the attainability of said mobile terminal device and in accordance with said received status change notification message about said change of said availability information when said change of said availability information indicates that said mobile terminal device will accept said message," (figure 2, column 9 lines 29-37, 53-64).

However, Salin et al. fail to specifically disclose that the message is forwarded when specific availability information indicates that the mobile station will accept the message.

In the same field of endeavor, Rooke et al. clearly show and disclose a method for delivering messages in a communication network consisting of at least one terminal and a messaging functionality, wherein the method comprises the steps of submitting information concerning the capabilities of the terminal and a current user profile thereof from said terminal to said messaging functionality upon the occurrence of a predetermined condition; deciding by said messaging functionality according to said information how to handle a message for said terminal received by said messaging functionality; and handling said message by said messaging functionality according to the result of said decision step, (paragraphs 8, 9). The decision how to handle the submission is based on the

circumstance that content(s), size and type(s) of the multimedia message, the capabilities of the terminal, and the user profile of a subscriber related to said terminal are available to respective decision means, (paragraph 19). The result of the decision as to how to handle the multimedia message can be that it shall be delivered completely, in part or modified, that it shall be discarded, stored in the multimedia messaging service center or forwarded, for example, to an internet email-address, reading on the claimed "checking (component; means) availability information of said mobile terminal device in said presence service for an indication of whether said mobile terminal will accept said message, initiating (component; means) a delivery attempt of said message to said mobile terminal when said availability information indicates that said mobile terminal device will accept said message, wherein said availability information comprises information selected from a group of type of message, size of the message, data content of the message, location of said mobile terminal device and willingness of a user of said mobile terminal device to receive a message," (paragraph 24).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to allow a MMSC to decide how a message should be handle before sending it as taught by Rooke et al. in the method of Salin et al. in order to reduce signaling when short messages are sent (Salin et al.; column 5 lines 34-35).

Consider **claim 3**, Salin et al., as modified by Rooke et al. clearly show and disclose the claimed invention **as applied to claim 1**, and in addition, Rooke

et al. further disclose that the submission of a multimedia message as an example for a message to be delivered in a communication network is handled according to capabilities and a user profile of a recipient terminal like for example a mobile station, reading on the claimed "message is a multi media message," (paragraph 19).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to allow multimedia messages to be delivered in a communication network as taught by Rooke et al. in the method of Salin et al. in order to permit subscribers to send a receive different types of messages.

Consider **claim 4**, Salin et al., as modified by Rooke et al., clearly show and disclose the claimed invention **as applied claim 1 above**, and in addition, Salin et al. further disclose the SM-SC receives a short message for delivery to the mobile station, reading on the claimed "receiving of said message to be transmitted to said mobile terminal device" (column 7 lines 63-65).

Consider **claim 5**, Salin et al., as modified by Rooke et al., clearly show and disclose the claimed invention **as applied claim 1 above**, and in addition, Salin et al. further disclose the SGSN sending information on the fact that the mobile station is again reachable, to the HLR, in response to the mobile station sending the SGSN a message on its presence. Then SMS-GSMC receives an alert from the HLR, reading on the claimed "checking availability information of

said mobile terminal device in said presence service for the availability of said mobile terminal device" (column 9 lines 30-37).

Consider **claim 6**, Salin et al., as modified by Rooke et al. clearly show and disclose the claimed invention **as applied to claim 1 above**, and in addition, Rooke et al. further disclose that a new multimedia message is received by the multimedia messaging service center (MMSC), which is able to decide which type of delivery has to be selected, based on the terminal capabilities and the current user profile stored in the MMSC, reading on the claimed "availability information for acceptance of said message is depending on properties of said message" (paragraph 20).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to allow the MMSC to the delivery of multimedia messages as taught by Rooke et al. in the method of Salin et al. in order to reduce signaling when short messages are sent (Salin et al.; column 5 lines 34-35).

Consider **claim 7**, Salin et al., as modified by Rooke et al. clearly show and disclose the claimed invention **as applied to claim 6 above**, and in addition, Rooke et al. further disclose that the decision how to handle the submission of a multimedia message is based on the circumstance that content(s), size and type(s) of the multimedia message, the capabilities of the terminal, and the user profile of a subscriber related to the terminal are available to decision means,

reading on the claimed "properties are selected from a group comprising: message type, message size, sender type, and sender" (paragraph 19).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to allow the MMSC to use the size and type of message to decide on delivery of multimedia messages as taught by Rooke et al. in the method of Salin et al. in order to reduce signaling when short messages are sent (Salin et al.; column 5 lines 34-35).

Consider **claim 8**, Salin et al., as modified by Rooke et al., clearly show and disclose the claimed invention **as applied claim 1 above**, and in addition, Salin et al. further disclose the mobile station updating its routing area and sending a message on its presence to the SGSN, which proceeds to send this information to the HLR, reading on the claimed "availability information of said mobile terminal device in said presence service can arbitrarily be changed by receiving said presence service status change message from said mobile terminal device" (column 9 lines 21-32).

Consider **claim 15**, Salin et al., as modified by Rooke et al., clearly show and disclose the claimed invention **as applied claim 13 above**, and in addition, Salin et al. further disclose the SM-SC receiving a short message for delivery to the mobile station, reading on the claimed "a component for receiving messages to be transmitted to said mobile terminal device" (column 7 lines 63-65).

Consider **claim 16**, Salin et al., as modified by Rooke et al., clearly show and disclose the claimed invention **as applied claim 12 above**, and in addition,

Rooke et al. further disclose that there are several possible conditions when to submit the information from the terminal to the multimedia messaging service center and the possibility of updating is not limited to only one condition.

However, the update should be coupled to the necessity to update, or at least to the possibility of submitting the information with other data (this can be any signaling sequence between these two network elements) that has to be submitted, in order to avoid a cluttering of traffic. Consequently, the condition when the terminal starts its signaling sequence to submit the information is predetermined. This condition can be a change of connection conditions of said terminal, a notification of said multimedia messaging service center concerning the presence and/or the contents of a new multimedia message to said terminal, or the like, reading on the claimed "a component configured to change said availability information in said presence service of said mobile terminal device according to the reception of a presence service status change message from said mobile terminal device" (paragraph 29).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to allow a MMSC to update the capabilities of the terminal when a presence notification is received as taught by Rooke et al. in the method of Salin et al. in order to reduce signaling when short messages are sent (Salin et al.; column 5 lines 34-35).

Consider **claim 18**, Salin et al., as modified by Rook et al., clearly show and disclose the claimed invention **as applied claim 17 above**, and in addition,

Rooke et al. further disclose that there are several possible conditions when to submit the information from the terminal to the multimedia messaging service center and the possibility of updating is not limited to only one condition. However, the update should be coupled to the necessity to update, or at least to the possibility of submitting the information with other data (this can be any signaling sequence between these two network elements) that has to be submitted, in order to avoid a cluttering of traffic. Consequently, the condition when the terminal starts its signaling sequence to submit the information is predetermined. This condition can be a change of connection conditions of said terminal, a notification of said multimedia messaging service center concerning the presence and/or the contents of a new multimedia message to said terminal, or the like, reading on the claimed "means for changing said availability information in said presence service of said mobile terminal device according to the reception of a presence service status change message from said mobile terminal device," (paragraph 29).

Consider **claim 19**, Salin et al. clearly show and disclose a method for delivering short messages to mobile stations. Salin et al. further disclose a situation where a mobile station MS is attached to a GPRS network and a GSM network, and the short message service center (SM-SC) has received a short message (SM) for delivery to the mobile station, but the mobile station cannot be reached. The SM-SC first forwards the short message to the gateway mobile switching center for short message service (SMS-GMSC) which proceeds to

request routing information for the short message from the home location register (HLR) of the mobile station, (abstract, column 7 lines 60-65 and column 8 lines 8-16) characterized by: sending a Set Message Waiting Data message to the HLR of the MS in response to a failed delivery attempt (Failure Report) to the SMS-GMSC, (figure 2, column 8 lines 39-42 and 59-62) and acknowledging receipt of Set Message Waiting Data message from SMS-GMSC to HLR, (figure 2, column 9 lines 1-4), sending alert message to SMS-GMSC, in response to mobile station updating its routing area to the serving node (SGSN) and the serving node sending this information to the HLR, (figure 2, column 9 lines 20-22, 30-32 and 35-37), forwarding short message to SMS-GSMC when SM-SC receives an alert message from the SMS-GMSC, (figure 2, column 9 lines 45-52), the SMS-GMSC examines the address of the mobile station and request routing information from the HLR which returns an acknowledgment of the message with the current SGSN address and the MSC/VLR address of the mobile station. The SGSN sends information on the fact that the mobile station is again reachable to the HLR which sends an alert message to the SMS-GMSC. The SMS-GMSC then sends an alert message to the SM-SC, which then forwards the short message to the SMS-GMSC, reading on the claimed "system, comprising a mobile terminal device, and a store and forward entity configured to receive a notification about an unsuccessful delivery attempt of a message to said mobile terminal device from said store and forward entity, wherein said store and forward entity is responsive to said notification about an unsuccessful delivery attempt, and is

configured to subscribe to a presence service for receipt of at least one notification about the attainability of said mobile terminal device, wherein said store and forward entity is configured to receive a status change notification message from said presence service about said mobile terminal device having a change of said availability information, wherein said store and forward entity is configured to initiate a delivery attempt of said message to said mobile terminal device upon receipt of at least one notification about the attainability of said mobile terminal device, and in accordance with said received status change notification message about said change of said availability information when said change of said availability information indicates that said mobile terminal device will accept said message," (figure 2, column 9 lines 29-37, 53-64).

However, Salin et al. fail to specifically disclose that the message is forwarded when specific availability information indicates that the mobile station will accept the message.

In the same field of endeavor, Rooke et al. clearly show and disclose a method for delivering messages in a communication network consisting of at least one terminal and a messaging functionality, wherein the method comprises the steps of submitting information concerning the capabilities of the terminal and a current user profile thereof from said terminal to said messaging functionality upon the occurrence of a predetermined condition; deciding by said messaging functionality according to said information how to handle a message for said terminal received by said messaging functionality; and handling said message by

said messaging functionality according to the result of said decision step, (paragraphs 8, 9). The decision how to handle the submission is based on the circumstance that content(s), size and type(s) of the multimedia message, the capabilities of the terminal, and the user profile of a subscriber related to said terminal are available to respective decision means, (paragraph 19). The result of the decision as to how to handle the multimedia message can be that it shall be delivered completely, in part or modified, that it shall be discarded, stored in the multimedia messaging service center or forwarded, for example, to an internet email-address, reading on the claimed "system comprising a mobile terminal device, and a store and forward entity wherein availability information in said presence service provides an indication of whether said mobile terminal device will accept said message wherein said store and forward entity is configured to initiate a delivery attempt of said message to said mobile terminal device when said availability information indicates that said mobile terminal device will accept said message, and wherein said availability information comprises information selected from a group of: type of message, size of the message, data content of the message, location of said mobile terminal device and willingness of a user of said mobile terminal device to receive a message," (paragraph 24).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to allow a MMSC to decide how a message should be handle before sending it as taught by Rooke et al. in the

method of Salin et al. in order to reduce signaling when short messages are sent (Salin et al.; column 5 lines 34-35).

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

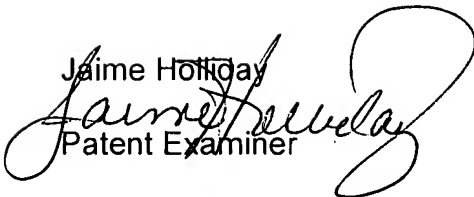
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jaime M. Holliday whose telephone number is (571) 272-8618. The examiner can normally be reached on Monday through Friday 7:30am to 4:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jaime Holliday

Patent Examiner


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER